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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/396,407 | 09/15/1999 | DAVID H. KOIZUMI | 2207/6657 | 7402 |

7590 10/05/2006

JOHN C. ALTILLER
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EXAMINER

LU, TOM Y

ART UNIT PAPER NUMBER

2624

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 09/396,407 | | KOIZUMI, DAVID H. | |
| | Examiner | | Art Unit | |
| | Tom Y. Lu | | 2624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-30 is/are allowed.
- 6) ☒ Claim(s) 6-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Request for Continued Examination filed on 8/18/2006 has been entered.
2. Upon entry of the Request for Continued Examination, the amendment and written response filed on 08/03/2006 have been entered and considered.
3. Claims 1-5 were cancelled.
4. Claims 6, 7, 20 and 24 were amended.

Response to Arguments

5. Applicant's arguments filed on 08/03/2006 have been fully considered but they are not persuasive.

The Armbruster reference:

Applicant argues the Armbruster fails to teach the added limitation of “a magnetic ink write head, coupled above the penpoint relative to the surface.” Upon further review of specification, and in light of applicant’s arguments, the examiner respectfully disagrees as follows: as explained in the previous office action dated 02/03/2006, page 9, the Armbruster reference clearly states “the recording heads 185 and 186 are shown as attached to the recording instrument 191, it will be realized that they may be *separately mounted and arranged to operate independently of said instrument if it is desired to provide more room and drying space between the formation of an ink character and the magnetic treatment of it.*” Such statement clearly gives the intention and desire to mount the claimed “magnetic ink write head”, numeral 186, higher to give more room and space between the formation of an ink character and the magnetic treatment of it. Although the Armbruster does not explicitly state the position must be “above the penpoint

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relative to the surface,” it is reasonable for a person of ordinary skill in the art to assume that “to provide more room and drying space between the formation of an ink character and the magnetic treatment of it”, mounting the magnetic ink write head above the penpoint is one of the ways to do so.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 12, 13, 14, 15, 16, 17 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Armbruster (U.S. Patent No. 3,376,551 A). The only under addressed limitation is “a magnetic write head, coupled above the penpoint relative to the surface,” the rest of limitations are addressed in previous office action dated 02/03/2006. For the undressed limitation, please see explanation in paragraph 5 above.

7. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Armbruster in view of Zacaroli (U.S. Patent No. 3,700,828 A). Please see rejection pages 17-19 in previous office action dated 02/03/2006.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Armbruster and Zacaroli as applied to claim 10 above, and further in view of Paine et al (U.S. Patent No. 3,566,045 A). See rejection on page 19 in previous office action dated 02/03/2006.

9. Claims 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Armbruster in view of Infosino (U.S. Patent NO. 6,715,679 B1). See rejection on pages 20-23 in previous office action dated 02/03/2006.

10. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Armbruster and Infosino as applied to claim 20 above, and further in view of Howbrook (U.S. Patent No. 4,369,431 A). See rejection on pages 23-24 in previous office action dated 02/03/2006.

Allowable Subject Matter

11. Claims 24-30 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

- a. Independent claim 24 defines a feature of applying a varying magnetic flux to the magnetic ink via a magnetic coil surrounding a magnetically permeable core such that said reservoir passes through said core and applying the varying magnetic flux to the magnetic ink is to store information in said magnetic ink as it is applied to the surface. Such feature in combination with other features in claim 24 is not taught or suggested by the art of record.
- b. Claims 25-30 are dependent upon claim 24.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Y. Lu whose telephone number is (571) 272-7393. The examiner can normally be reached on 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on (571)-272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TYL



JINGGE WU
PRIMARY EXAMINER